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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,364	10/25/2001	Clive P. Hohberger	7887/83889	3268

7590

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EXAMINER

DO, AN H

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/001,364

Applicant(s)

HOHBERGER ET AL.

Examiner

An H. Do

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 141-152 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 141-152 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

This is the second Office Action on the merits responsive to the filing of the pending application.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-13 and 141-152 are rejected under 35 U.S.C. 102(e) as being anticipated by Petteruti et al (US 6,409,401 B1).

Regarding claims 1 and 2, Petteruti et al discloses in Figures 1-3 a media printer (10) comprising means for moving (20, 21) a plurality of media samples (column 3, line 8) from a supply (14); means for printing (18) information on at least selected ones (16) of the media samples; and means for attaching (column 3, lines 4-7) value-adding devices (16a) which are radio frequency identification transponders (RFIDs).

Regarding claims 3 and 4, it is disclosed means for determining (34) whether the RFIDs are defective or misprogrammed and means for causing a failure indicia to be printed (column 4, lines 56-67 and column 5, lines 1-3).

Regarding claims 5 and 6, it is also disclosed in Figure 1B that a plurality of value-adding devices (16a) are attached to one of the media samples (16) such as labels (column 3, lines 8-9).

Regarding claims 7-9, Petteruti et al discloses in Figures 1-3 a media printer (10) comprising a media supply (14) and a media exit (13); a generally continuous web (16) that operably interconnects the media supply (14) and the media exit (13); a printhead (18) in operative relation to the web (16) to print information on a first surface (column 3, lines 9-11); and an applicator mechanism (not shown) that is mounted in operative relation to the web (16) to couple (column 3, lines 4-7) the value-adding device (16a) to a second surface (column 3, lines 11-12) such as RFID in contact with an antenna (23).

Regarding claims 10 and 11, it is further disclosed a verification mechanism (34) to verify the operation of the RFIDs and causes failure indicia to be printed (column 4, lines 56-67 and column 5, lines 1-3).

Regarding claims 12 and 13, it is disclosed in Figure 1B that a value-adding device (16a) is attached to one of the media samples (16) such as labels (column 3, lines 8-9).

Regarding claims 141-143, Petteruti et al discloses in Figures 1-3 an on-demand printer (10) for printing information on a series of labels, tickets, tags, cards or other media (column 3, lines 8-9), comprising a media feeder (20) adapted to feed a web of media samples (16) through a dispensing station (Figure 1); and a dispenser (not shown) located at the dispensing station and configured to associate (column 3, lines 4-

7) a discrete value-adding element with certain media samples (16). The value-adding element is an RFID with circuit (16a) making contact with an antenna (23).

Regarding claims 144 and 145, it is further disclosed means (34) for communicating with the RFID and means for reading or writing (22) information stored in the RFID.

Regarding claims 146 and 147, it is disclosed means for processing the media including a printing apparatus (36).

Regarding claims 148-151, it is also disclosed means (34) for communicating with the RFID; the printing apparatus is responsive to communicating means and prints results (column 4, lines 40-50).

Regarding claim 152, it is disclosed in Figure 3 means for associating is controlled by a computer program (column 4, lines 33-38).

### ***Allowable Subject Matter***

3. The indicated allowability of claims 7-13 is withdrawn in view of the newly discovered reference(s) to Petteruti et al (US 6,409,401 B1). Rejections based on the newly cited reference(s) follow.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-13 and 141-152 have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to An H. Do whose telephone number is 703-308-0525. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell E. Adams can be reached on 703-308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



AD  
May 23, 2003



JUDY NGUYEN  
PRIMARY EXAMINER